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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,156	03/27/2001	Arvind Padole	60001.0030US01/MS15467.1	1937
27488	7590	08/24/2004	EXAMINER	
MICROSOFT CORPORATION C/O MERCHANT & GOULD, L.L.C. P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			NALVEN, ANDREW L	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,156

Applicant(s)

PADOLE ET AL.

Examiner

Andrew L Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/25/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 are pending.
2. IDS submitted 25 May 2001 has been received and considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 8, 10, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Schoch et al US Patent No. 6,460,140. Schoch discloses a system for controlling the use of licensed software.
5. With regards to claim 1, Schoch teaches the obtaining of a local license from a storage medium of the software product and storing the local license with the software product on the computer by inputting a product key and obtaining the local license (Schoch, column 3 line 61 – column 4 line 2, column 4 lines 44-46, “registration key” as local license and “validation number” as product key), determining a license type and an installation ID for the software product wherein the installation ID comprises a product ID (Schoch, column 4 lines 44-46), transmitting the installation ID to an activation

authority (Schoch, column 4 lines 3-7), at the activation authority, determining whether the product ID has been used to activate the software product before and determining the type of backend license to grant (Schoch, column 4 lines 7-15, "license key", column 3 lines 55-60), and transmitting a backend license to the computer (Schoch, column 4 lines 11-12).

6. With regards to claim 2, Schoch teaches the local license allowing for one of a plurality of license types to be activated from the software product (Schoch, column 3 lines 48-60, generates license key with options).

7. With regards to claim 8, Schoch teaches everything described above, and further teaches the generating of a product ID from the product key and a backend product code (Schoch, column 4 lines 1-15 and 40-46, validation number and serial number).

8. With regards to claim 10, Schoch teaches the backend license granting the user perpetual or temporary rights to use the software package (Schoch, column 3 lines 55-60).

9. With regards to claim 12, Schoch teaches everything described above, and further teaches the installation ID further comprising a hardware ID describing the hardware of the computer (Schoch, column 4 lines 61-66, unique computer identification) and the storing of the PID, HWID, and an identifier of a backend license in a database (Schoch, column 2 line 63 – column 3 line 2).

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-7, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schocher et al US Patent No. 6,460,140 in view of Larose et al US Patent No. 6,108,420. Larose discloses a system for networked installation of uniquely customized authenticable and traceable software applications.

12. With regards to claims 3 and 9, Schoch, as described above, teaches a product key, but fails to teach the product key comprises a channel ID. Larose teaches the use of a channel ID in a product key (Larose, column 5 lines 27-29, "the seller"). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Larose's inclusion of a channel ID with Schoch's licensing system because it offers the advantage of providing a means to customize licensing terms for particular user (Larose, column 3 lines 31-35).

13. With regards to claim 4, Schoch as modified teaches the local license comprising a MDIID, a channel ID range for each supported license type, a license type for each channel ID range, and an optional product expiration date for the license type (Schoch, column 3 lines 48-60, Larose, column 6 lines 45-49).

14. With regards to claim 5, Schoch as modified teaches the license type being determined by searching for the product key's channel ID in the local license's channel ID range (Larose, column 5 lines 27-29 and 43-52).

15. With regards to claim 6, Schoch as modified teaches the installation ID further comprising a hardware ID describing the hardware of the computer (Schoch, column 4 lines 61-66, unique computer identification).
16. With regards to claim 7, Schoch as modified teaches the activation authority using the channel ID to determine the type of backend license to grant (Larose, column 5 lines 27-29 and 43-52).
17. With regards to claim 11, Schoch as modified teaches the BPC used to verify the backend license from the activation authority (Schoch, column 4 lines 11-15).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. Ross et al US Patent No. 5,553,139 discloses a method for electronic license distribution.
20. Horstmann US Patent No. 6,009,401 discloses a re-licensing system for electronically purchased software.
21. Colosso US Patent No. 6,169,976 discloses a method and apparatus for regulating the use of licensed products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 703 305

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8407. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703 308 4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



GREGORY MORSE
SUPERVISORY PATENT EXAMINER
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